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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,249	03/02/2004	Mariko Aduma	116692005100	9890
25227 7590 06/27/2008 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				
EXAMINER				
MISLASZEK, MICHAEL				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
06/27/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,249

Applicant(s)

ADUMA ET AL.

Examiner

Michael Misiaszek

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s) Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s) Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/1/2008 has been entered.

Response to Amendment

Applicant's amendments filed 4/1/2008 have been received and reviewed. The status of the claims is as follows:

Claims 1-4, 6, and 7 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tavor in view of Tell et al. (US 20040054614 A1, hereinafter Tell).

Regarding Claims 1, 7

Tavor discloses a product information contrast system and computer program product which contrasts a plurality of items of product information that contain specifications indicating properties of products, comprising:

- a product information management unit managing the plurality of items of product information of the products including a criterion product (at least paragraph [0012]: memory used to store product information)
- a threshold setting unit setting a threshold value for the product information items of the criterion product, which is provided to determine whether specifications of product information items of the criterion product indicate any differing property when compared with the specifications of the product information items of other of the products (at least paragraph [0023]: ranges of values associated with topics set)

- a judgment unit determining whether a product property indicated by the specifications in the product information items of the criterion product is different from a corresponding product property indicated by specifications in the product information items of at least one of the other products managed by the product information management unit, based on the threshold value from the threshold setting unit (at least paragraph [0012]: comparison module compares product information)
- a display control unit generating a visually recognizable display indication of differences in the specifications of the product information items based on results of the determination of the determining whether the specifications in the product information items of the criterion product are different from specifications in the product information items of at least one of the products managed by the product information management unit, based on the threshold value (at least abstract: results of comparison output to standard output write functions)

The Examiner notes that Tavor does not explicitly disclose that the differing properties are one of a newly set property, and omitted property, or an out-of-range property. However, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited or functionally related to the substrate of the system. The threshold setting and information comparison would be performed in the same manner, regardless of how the differing properties are identified. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.2d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to identify the differing properties using any convention because such information does not functionally relate to the steps in the method claimed and merely labeling the properties differently from that in the prior art would have been obvious. See *Gulack* cited above.

Tavor further does not explicitly close that the threshold values include percentages input by an administrator. The Examiner does not necessarily agree with the applicant's assertion that the percentages included in the claimed threshold value are not non-functional. However, for purposes of completeness, a reference has been cited below as teaching the feature.

Tell teaches that it is known to include inputting percentages as threshold values when comparing products (at least paragraph [0059]: threshold percentages input for comparing financial products) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system and method, as taught by Tavor, with the percentages as threshold values, as taught by Tell, since such a modification would have provided a more streamlined financial instrument market through filtering out of undesirable entities (at least paragraph [0029] of Tell).

Regarding Claims 2, 3, 4

Tavor further discloses:

- a selection unit selecting arbitrary one of the product information items of the products, managed by the product information management unit, as being one of the product information items of the criterion product (at least paragraph [0009]: topics for comparison selected)
- the display control unit is configured to generate a visually recognizable alarm display indication when the results of the determination of the judgment unit indicate that the specifications of the product information items of the criterion product are not included in the specifications of the product information items of said at least one of the products (at least paragraph [0050]: output generated for distinct products)
- the display control unit is configured to generate a visually recognizable alarm display indication when the results of the determination of the judgment unit indicate that any specifications other than the specifications of the product information items of the criterion product are included in the product information items of said at least one of the products (at least paragraph [0050]: output generated for distinct products, i.e. product with differing specifications)

Regarding Claim 6

Tavor further discloses:

- a display control information management unit managing display control information to control the alarm display indication based on an input threshold value and a predetermined range of the input threshold value (at least paragraph [0025]: natural language output determined based on range and thresholds by module)
- the display control unit configured to generate the visually recognizable alarm display indication of the differing property, based on both the results of the determination of the judgment unit and the display control information managed by the display control information management unit (at least paragraph [0025]: natural language output determined based on range and thresholds by module;
Examiner Note: see non-functional descriptive material note and *Gulack* citation above)

Response to Arguments

Applicant's arguments with respect to the disclosure of the cited prior art have been fully considered, but they are not persuasive. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments with respect to the Examiner's conclusions that the various property determinations are non-functional descriptive material have been fully considered, but they are not persuasive. Applicant asserts that a property being newly set, omitted, or out-of-range results from the determination process as claimed, the property determinations cannot be considered non-functional. The Examiner respectfully disagrees. The property determinations recited are merely labels for property differences found when the threshold setting and comparing steps are performed within the method/system. The prior art (namely Tavor) discloses the threshold setting and product property ("topic" in Tavor) comparison. Tavor merely identifies the property differences in a different manner (using natural language output) than the differences are identified in the claimed invention ("newly set", "omitted", "out-of-range"). However, the steps performed in Tavor are performed in the same manner as recited in the claims. Accordingly, since the identification of the differing properties does not change the function of the system, or the steps performed by the computer program product, such identification is merely non-functional descriptive material.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Misiaszek whose telephone number is (571)272-6961. The examiner can normally be reached on 9:00 AM - 5:30 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art
Unit 3625

Michael Misiaszek
Patent Examiner
6/22/2008

Application Number**Application/Control No.**

10/790,249

Examiner

Michael Misiaszek

**Applicant(s)/Patent under
Reexamination**

ADUMA ET AL.

Art Unit

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